

REMARKS/ARGUMENTS

Upon entry of the instant amendment, claims 13-18, 25, 26, 29 and 34 will be canceled without prejudice or disclaimer of the subject matter recited therein, and claims 27, 30, 33, 35 and 42 will be amended, whereby claims 27, 28, 30-33 and 35-42 will remain pending. Claims 27, 33, 39 and 42 are independent claims.

Applicants note that support for the amendment to claims 27, 33 and 42 to change “a nitrogen atom which may be substituted with a C₁-C₁₈ alkyl group which may be substituted” with --- NH or a nitrogen atom substituted with a C₁-C₁₈ alkyl group which may be substituted--- is supported by Applicants’ originally filed disclosure including the fact that the nitrogen atom may be substituted and well as compounds such as compounds 173 and 174 in Applicants’ Table 1. Moreover, this amendment clarifies that the bond between -N(R⁴) and W is a single bond.

Reconsideration and allowance of the application are respectfully requested.

Response To Objection To Claim 39

Applicants note that the Office Action has not rejected claim 39, but has only objected to this claim as being dependent upon a rejected base claim. However, claim 39 is an independent claim whereby an objection to this claim as being dependent upon a rejected base claim is improper.

In view of the above, Applicants respectfully submit that claim 39 is in allowable form, and Applicants respectfully request that claim 39 be indicated to be allowable.

Response To Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 13-18, 25-38 and 40-42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In this ground of rejection, the Examiner asserts several grounds of indefiniteness. In particular, it is asserted that “may be substituted” is indefinite without substituents following the phrase; that claims 25 and 26 are substantial duplicates of claims 13 and 18; and it is questioned whether the bond between $-N(R^4)$ and W is a double or single bond.

In response, Applicants respectfully submit that the claim terminology is readily understandable to one having ordinary skill in the art, whereby the metes and bounds of the claimed subject matter is of a clear scope. However, in order to advance prosecution of the application, Applicants have amended claims 27, 33, and 42 as noted above to clarify that the bond between $-N(R^4)$ and W is a single bond. Moreover, claims 13, 18, 25 and 26 have been canceled so that the indefiniteness rejection with respect to these claims is moot.

Regarding the terminology “may be substituted”, Applicants respectfully submit that one having ordinary skill in the art would readily be capable of understanding the metes and bounds of Applicants’ claims especially when read in light of the detailed disclosure of substituents in Applicants’ specification, such as beginning at page 9 of the specification.

The Examiner is reminded that a fundamental principle contained in 35 U.S.C. 112, second paragraph, is that Applicants can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. Applicants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear

the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. In the instant situation, one having ordinary skill in the art would readily comprehend substituents in Applicants' claims, especially in view of the examples of substituents provided in the originally filed disclosure. See also *In re Hansen and Couticos*, 141 USPQ 803 (CCPA 1964) and *Ex parte Breuer*, 1 USPQ2d 1906 (BPAI 1986).

In view of the above, Applicants respectfully submit that this ground of rejection should be withdrawn.

Response To Rejection Under 35 U.S.C. 112, First Paragraph

Claims 13-15, 17, 18, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as the Examiner asserts that, while the specification is enabling for the treatment of Alzheimer's disease, the specification does not provide enablement for the treatment of any disease mediated by tau protein kinase 1.

In particular, the Examiner asserts that claims 13 and 25 still cover the treatment for numerous diseases both known and unknown in the art, and that the art only associates tau protein kinase 1 with Alzheimer's disease.

In response, Applicants note that the rejected claims have been canceled without expressing any agreement or acquiescence with the rejection of record, while preserving Applicants' right to prosecute these claims in one or more continuation applications.

Response To Rejections Based Upon Art

Claims 27-29, 31-34, 36-38, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spohr et al., U.S. Patent No. 6,096,753, in view of Spohr et al., U.S. Patent No. 6,410,729.

In this ground of rejection, the rejection notes several compounds in column 138 of Spohr '753 (not all lines indicated in the rejection have compounds therein), notes a difference in that -CH₃ is bonded to the ring nitrogen atom, but then asserts that Spohr '729 renders obvious a lack of alkylating of the ring nitrogen of Spohr '753.

In response, Applicants note that in contrast to the compounds disclosed in Spohr '753, the presently claimed compounds do not include a methyl group on a ring nitrogen atom, and do not include an alkyl group as R². Still further, Spohr '753 and Spohr '729 fail to teach or suggest that their disclosed compounds have inhibitory activity against tau protein kinase 1, whereas the compounds according to the present invention have a potent inhibitory activity against tau protein kinase 1, and thus are useful for treatment of Alzheimer's disease. The difference of the activity derives from the difference of the structures of the compounds, and there is no teaching or suggestion in Spohr '753 whether taken alone or in combination with Spohr '729 to arrive at Applicants' disclosed and claimed invention.

In view of the structural difference of the compounds disclosed in Spohr '753 and Spohr '729 and the lack of teaching of the pharmacological action relating to tau protein kinase inhibitor in either of Spohr '753 or Spohr '729, one having ordinary skill in the art would not have been

motivated to arrive at Applicants' compounds having inhibitory activity against tau protein kinase 1 by modifying Spohr '753 in view of Spohr '729.

Applicants further note that Spohr '753 is directed to specific compounds, and one having ordinary skill in the art would not have been motivated to modify the disclosure of Spohr' 753 in the manner asserted in the rejection. For example, there is no direction to pick and choose certain compounds in Spohr '753 and modify these compounds based upon Spohr '729.

Still further, while not necessary to establish patentability in view of the lack of a prima facie case of obviousness, Applicants note that the presently claims compounds process advantageous effects over the Spohr '753 and Spohr '729, such as depicted in Table 2 of Applicants' specification.

Accordingly, the rejection of record should be withdrawn.

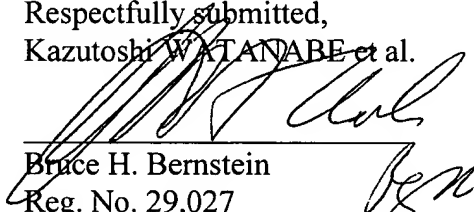
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow all the pending claims.

Allowance of the application is requested, with an early mailing of the Notices of Allowance and Allowability.

If the Examiner has any questions or wishes to further discuss this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,
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